

## REMARKS

With entry of this Amendment, claims 1-10 and 27-54 are pending in the application. Claims 1, 8, 27, 30, 36, 39, 40, 43 and 47 are currently amended. Claim 30 has been rewritten in independent form to include the elements and limitations of independent claim 27. Claims 11-26 were previously canceled. Claims 7, 37 and 38 were presently withdrawn from consideration. New claims 51-54 are added. The amendments and new claims do not present any new matter. See, e.g., para. 84 (shaft distal section 108 includes outer member 122 that is flexible tubular structure); para. 87 (distal section 108 may be formed by a hypotube). Reconsideration and allowance of the application, as amended, are respectfully requested.

### I. Withdrawn Rejections

Applicant acknowledges and appreciates that the prior rejections based on U.S. Patent No. 6,771,996 to Bowe *et al.* and U.S. Patent No. 6,115,626 to Whayne *et al.* have been withdrawn.

### II. Claims 1-6, 8-10, 27-29 and 31-50 Are Novel Over Sherman

Independent claims 1, 27 and 47 and respective dependent claims 2-6, 8-10, 28, 29, 31-46 and 48-50 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Sherman. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Applicant respectfully traverses the rejection since Sherman fails to anticipate any claim of the subject application.

Initially, Sherman fails to disclose, teach or suggest a coagulation element . . . on the distal region of the same relatively short tubular shaft" and "a stimulation element . . . on the distal region of the same relatively short tubular shaft" as recited in claims 1 and 27 and means for coagulating tissue "on the distal region of the same relatively short tubular shaft" and means for stimulating tissue "on the distal region of the same relatively short tubular shaft" as recited in claim 47. The Office Action alleges that the "relatively short shaft" is the portion of the portion of an inner shaft 12 extending between the distal end of the inner shaft 12 and an o-ring seal 32. The Office Action further alleges that a ring electrode 18 is a "coagulation element" and that the radiopaque markers 38a and 38b define a "stimulation element."

However, as described by Sherman, the ring electrodes 18 and markers 38a and 38b are on different shafts. More specifically, Sherman describes a catheter device 10 having "an inner

shaft 12 and an outer shaft 14.” Sherman (col. 4, lines 1-2). “Inner shaft 12 extends telescopically through the outer shaft 14.” Sherman (col. 4, lines 2-3). This “two-shaft” catheter uses a window 36 that is formed in the outer shaft 14 and permits fluid flow out of the window. Sherman (col. 5, lines 25-28). During use, relative positions of the inner and outer shafts 12 and 14 are adjusted by sliding one relative to the other so that electrodes 18 and fluid openings 20 are within the window 36. RF energy is delivered to tissue once the window 36 is in contact with the desired tissue region. Sherman (col. 5, line 61 - col. 6, line 2).

Thus, Sherman fails to disclose, teach or suggest the “same relative short tubular shaft” limitations of claims 1, 27 and 47. In fact, Sherman describes a configuration that is the opposite of claims 1, 27 and 47. Further, given the particular configuration and use of these slideable or telescoping shafts 12 and 14 and window 36, there would be no suggestion or motivation to modify Sherman to have a single shaft, and doing so would significantly alter the device described by Sherman or render it inoperable.

In view of these substantial differences, Applicant respectfully submits that Sherman does not anticipate independent claims 1, 27 and 47 under §102(b). Dependent claims 2-6, 8-10, 28, 29, 31-46 and 48-50 incorporate the elements and limitations of respective independent claims 1, 27 and 47 and, therefore, are also allowable over Sherman for at least the same reasons.

Further, Sherman fails to disclose, teach or suggest “wherein the coagulation energy connector and stimulation energy connector define different configurations” as recited in claim 29. The Office Action generally refers to col. 3, line 66 - col. 7, line 38 and six different figures to support the rejection, but does not specifically identify connectors defining different configurations.

Sherman also fails to disclose, teach or suggest “wherein the source of stimulation energy is configured for monitoring electrical impulses sensed by the stimulation element” as recited in claim 36. The Office Action refers to col. 7, lines 4-38 of Sherman. The cited section describes comparing electrical responses of tissue, but not that the assertedly “inherent” source of stimulation energy is configured for monitoring electrical impulses sensed by the stimulation element.

Additionally, Sherman fails to disclose, teach or suggest “the coagulation element and the stimulation element are carried on the same relatively short tubular shaft such that the coagulation element and the stimulation element are longitudinally fixed relative to one another” as recited in claims 39 and 43. In contrast, as discussed above, Sherman describes to separate

shafts, an inner shaft 12 and an outer shaft 14, and the inner shaft 12 is slidably movable within the outer shaft 14. Thus, Sherman describes a configuration that is the opposite of that recited in claim 38, which recites the “same” relative short shaft, and the coagulation and stimulation elements are longitudinally “fixed” relative to one another.

Sherman also fails to disclose, teach or suggest “wherein the distal portion of the relatively short tubular shaft includes a unitary outer member and the coagulation element and the stimulation element are both carried on the unitary outer member” as recited in claims 40 and 44. Rather, as discussed above, Sherman describes two separate shafts. One or more electrodes 18 encircle the distal end of the inner shaft 12, and the outer shaft can include markers 38a and 38b. Thus, Sherman describes a configuration that is the opposite of that recited in claim 40.

Additionally, Sherman fails to disclose, teach or suggest “wherein the coagulation element and the stimulation element define respective diameters and the diameter of the coagulation element is substantially equal to the diameter of the stimulation element” as recited in claims 42 and 46. Sherman describes electrodes 18 on the inner shaft 12 as ring electrodes, but shows markers 38a and 38b as elements on the outer shaft 14 that do not surround the outer shaft 14. Sherman (Fig. 1). Moreover, the inner shaft 12, by definition, has a diameter that is smaller than the diameter of the outer shaft 14 since it can slide within the outer shaft 14.

Accordingly, Applicant respectfully requests that the rejection of claims 1-6, 8-10, 27-29 and 31-50 under 35 U.S.C. §102(b) based on Sherman be withdrawn.

#### **IV. Claims 1, 27, 28, 30, 39 and 43 Are Novel Over Hooven**

Independent claims 1 and 27 and respective dependent claims 28, 30, 39 and 43 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 6,889,694 to Hooven (“Hooven”). Applicant respectfully traverses the rejection since Hooven fails to anticipate any claim of the subject application.

Hooven does not disclose, teach or suggest “a relatively short tubular shaft defining a distal region and a proximal region” as recited in claim 1. The Office Action alleges that a fixed jaw assembly 116 is a “shaft” as recited in claim 1. The jaw assembly 116, however, is not a “tubular shaft” as recited in claims 1 and 27. Consistent with this conclusion is that Hooven refers to a fixed jaw assembly 116 and a shaft (including members 132 and 134) as different components. Hooven (col. 11, lines 24-34 (curved, fixed jaw assembly 116), (col. 11, lines 56-62 (extension shaft). The subject application also notes these differences. Para. 101 (As used

herein, the term "clamp" includes, but is not limited to, clamps, clips, forceps, hemostats, and any other surgical device that includes a pair of opposable clamp members that hold tissue, at least one of which is movable relative to the other); para. 8 (clamps, which have a pair of opposable clamp members); para. 79 (relatively short shaft 102 with a proximal section 104, which is connected to a handle 106, and a distal section 108, on which coagulation electrodes 110 are supported); para. 158 (shaft 606). Accordingly, the position taken in the Office Action regarding Hooven is contrary to the description provided by Hooven. Thus, Applicant respectfully requests that the rejection of independent claims 1 and 27 under §102(b) be withdrawn, since Hooven does not anticipate these claims. Dependent claims 28, 30, 39 and 43 incorporate the elements and limitations of respective independent claims 1 and 27 and, therefore, are also allowable over Hooven for at least these same reasons.

#### **V. New Claims 51-54 Are Novel Over Sherman and Hooven**

Dependent claims 51-54 incorporate the elements and limitations of respective independent claims 1 and 27 and, therefore, are also novel over Sherman and Hooven. MPEP 2143.03.

Further, Hooven fails to disclose, teach or suggest "wherein the relatively short tubular shaft is linear" as recited in claims 51 and 52. The Office Action asserts that the "shaft" as recited in the claims is jaw member assembly 116. Hooven, in contrast, describes the assembly 116 as a "curved jaw" assembly 116.

Hooven also fails to disclose, teach or suggest "wherein the relatively short tubular shaft and the handle are coaxial" as recited in claims 53 and 54.

**CONCLUSION**

Applicant respectfully requests entry of this Amendment, and submits that doing so will place the application in condition for allowance in view of the forgoing amendments and remarks. If there are any remaining issues that can be resolved by telephone, Applicant invites the Examiner to kindly contact the undersigned at the number indicated below.

Respectfully submitted,

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Dated: April 25, 2007

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